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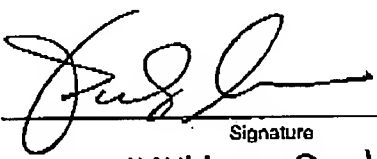
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) CU-3570	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>December 10, 2007</u> Signature <u>Ben Horton</u> Typed or printed name <u>Ben Horton</u>		Application Number 10/779,415	Filed 02/13/2004
		First Named Inventor Ogino, Toshikazu	
		Art Unit 2611	Examiner Timory, Kabir A.
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. 55,523 Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature <u>W. William Park</u> Typed or printed name 312-427-1300 Telephone number Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Application Serial No. 10/779,415
Pre-Appeal Brief

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application: Toshikazu OGINO

] GRP ART UNIT: 2611

Serial No: 10/779,415

] Ex.: Timory, Kabir A.

Filed: February 13, 2004

For: COMMUNICATION SYSTEM AND COMMUNICATION DEVICE

Certification under 37 C.F.R. §1.8(b)

The USPTO Central Fax No. (571) 273-8300

Date of Fax Transmittal: December 10, 2007

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted to the United States Patent and Trademark Office to the fax number and on the date indicated above.


Ben Horton

PRE-APPEAL BRIEF ARGUMENTS AND REMARKS

MAIL STOP AF

The Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

Pre-Appeal review is requested for U.S. Patent Application No. 10/779,415 ("Ogino") filed on February 13, 2004. A final office action was mailed on July 9, 2007, in reply to which the applicant has filed Amendment After Final on October 9, 2007. An Advisory Action has then mailed on October 19, 2007 to address the Amendment After Final filed October 9, 2007. However, the examiner has failed to address the arguments regarding the lack of a prima facie showing of obviousness under 35 U.S.C. § 103 set forth by the applicant in the Amendment After Final.

A Notice of Appeal together with Pre-Appeal Brief For Review accompanying this Pre-Appeal Brief Arguments and Remarks are being filed herewith. Also enclosed is the Request for Two-Month Extension of Time, thereby extending the end date of the current term to Monday, December 10, 2007.

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The Commissioner is authorized to charge the fee for filing the Notice of Appeal (\$500 for large entity) and the Request for Two-Month Extension of Time (\$460 for large entity) to Deposit Account No. 12-0400. No other fee is believed to be required, but, if this is not the case, please charge any additional fee or credit any overpayment to Deposit Account No. 12-0400.

I. The Amendment After Final filed on October 9, 2007

The applicant clearly asserted in the Amendment After Final on pages 5-6 that the examiner provides no sufficient motivation or suggestion to combine U.S. Patent No. 5,812,607 (Hutchinson) and U.S. Patent No. 5,471,209 (Sutterlin). According to MPEP 2146.01, any proposed modification cannot change the principles of operation of a reference. MPEP 2146.01(V)(i) states, *inter alia*:

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)."

The applicant has clearly demonstrated that a modification of Hutchinson as suggested by the examiner would fundamentally change the principle operation of Hutchinson, and therefore the examiner has failed to present a *prima facie* showing of obviousness as required under MPEP 2146.01 (V)(i). More specifically, the applicant argues that applying the 1-bit quantization of Sutterlin to Hutchinson would change the principle operation of Hutchinson, because the RF transmitter 64 is prevented from transmitting the modulated signal (the Amendment After Final page 5, bottom to page 6, top). The applicant further stresses the remarkable effects of the presently claimed invention as described in the specification page 19, line 25 to page 20, line 10. The combination of Hutchinson and Sutterlin cannot succeed and would not yield the remarkable effects described by the applicant. Finally, the applicant argues that Hutchinson does not teach or suggest the use of an analog-to-digital converter as required by the presently claimed invention. Sutterlin discloses a sigma-delta A/D converter; however, absent any mention of an A/D converter in Hutchinson, there is no

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motivation to combine Hutchinson and Sutterlin (the Amendment After Final page 6, bottom to page 7, top).

II. The Advisory Action mailed on October 19, 2007

In the Advisory Action of October 19, 2007, the examiner responds to the arguments set forth in the Amendment After Final of October 9, 2007. However, the examiner has failed to address the arguments set forth by the applicant in the Amendment After Final of October 9, 2007 and therefore still has not met its burden of producing a prima facie case of obviousness against the applicant.

In the Advisory Action, the examiner rightly recognizes his initial burden of presenting a prima facie case of obviousness; however, the Advisory Action following the acknowledgment provides no such support. In the Advisory Action, the examiner merely describes the invention of Hutchinson noting, "the transmitted digital information signals are generated within the dualmode transmitter through FM Modulation of an RF carrier" (Advisory Action ¶ 2). The examiner then summarizes Sutterlin noting that Sutterlin "teaches a converter, which is comprised of a first order sigma delta modulator" (Advisory Action ¶ 2). However, the examiner makes no indication as to the motivation to combine the two references. Rather, the examiner attempts to shift the burden onto the applicants. The examiner states "[t]he Applicant does not rebut any of these assertions" (Advisory Action ¶ 2). This is immaterial and does not aid the examiner in fulfilling his burden of establishing a prima facie case of obviousness against the applicant.

From the Advisory Action, the examiner relies on his own knowledge to combine Hutchinson and Sutterlin. Specifically, the examiner "relies on the benefits of the one-bit quantization" and "also its simplicity and inexpensive method of DAC conversion to conclude that that one of ordinary skill in the art would have been motivated to combine the references" (Advisory Action ¶ 2). The examiner provides no rationale to combine Hutchinson and Sutterlin other than his assumptions of what one of ordinary skill might do.

III. The Lack of Prima Facie Showing of Obviousness

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The examiner's argument set forth in the Advisory Action does not support any motivation to combine Hutchinson or Sutterlin. The examiner is clearly in error. The examiner has attempted to establish that the "simplicity and inexpensive method of DAC" in Sutterlin is motivation to combine it with Hutchinson. This is **not** sufficient motivation for combination for the following reasons.

First, the examiner has failed to recognize key differences in Hutchinson and Sutterlin. As MPEP 2146.01(V)(i) states, *inter alia*:

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)."

Hutchinson does not disclose an analog to digital converter anywhere within the specification. Rather, Hutchinson specifically discloses a digital to analog converter 62 as shown in FIG. 1. There is no reason to implement an analog to digital converter in Hutchinson as alleged by the examiner and to do so would fundamentally change the operation of Hutchinson. The examiner stated in the Advisory Action "the transmitted digital information signals are generated within the dualmode transmitter through FM Modulation of an RF carrier" (Advisory Action ¶ 2). This modulation of an RF carrier would not operate the same, if at all, if the information was converted from analog to digital as alleged by the examiner. Further, the analog receiver 84 of Hutchinson would be ineffective, as digital information would be transferred, not analog. Such a modification as alleged by the examiner would require a change in principle operation of Hutchinson in direct contrast to MPEP 2146.01(V)(i).

The examiner's argument also rests on **impermissible hindsight**. MPEP 2145(X)(A) states, *inter alia*:

However, "[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

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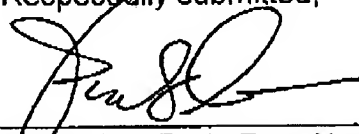
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The examiner in the Advisory Action relies on the benefits of one-bit quantization as a reason for its use. However, such benefits as it pertains to the present invention would not be apparent without the disclosure of the present invention and is thus impermissible hindsight reasoning as defined under MPEP 2145(X)(A).

IV. Conclusion

The examiner has failed to meet its burden of providing a prima facie case of obviousness against the applicant. The applicant has set forth a valid argument in its Amendment After Final as to the lack of motivation for combination of the prior art references cited. In response, the examiner in the Advisory Action has failed to rebut any arguments set forth by the applicant in the Amendment After Final. Rather, the examiner has ignored glaring differences between the prior art and has ignored MPEP 2143.01(V)(i) and MPEP 2145(X)(A). Therefore, the examiner has failed to meet its burden of establishing a prima facie case of obviousness against the present U.S. Patent Application No. 10/779,415, and the applicant respectfully requests withdrawal of the rejection and an indication of allowability.

Respectfully submitted,



Dated: December 10, 2007

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